

REMARKS/ARGUMENTS

Reexamination and reconsideration of this Application, withdrawal of the rejections, and formal notification of the allowability of all claims as now presented are earnestly solicited in light of the above amendments and remarks that follow. Claims 4, 8, 9, 12-14, 20, 24-27, 33, and 36-46 are pending in the application. Claims 21, 34, 35 have been cancelled without prejudice or disclaimer in light of the amendments to claim 27. Claim 27 has been amended to recite that the breakable capsule comprises a gelatin outer shell and an internal payload comprising a flavoring agent and a triglyceride diluting agent. New claim 46 recites the use of a cooling agent as the flavorant. Support for these amendments can be found throughout the specification, such as on pages 22 and 23.

Applicants respectfully request withdrawal of the finality of the last Office Action. As explained more fully below, the Examiner has not adequately addressed all limitations of the only independent claim (claim 27). Accordingly, Applicants have not been given sufficient notice of the Office's position to respond to the rejections. In particular, it is noted that the Examiner has not explained, or even addressed, how the combination of Jupe and Tateno teach or suggest a fibrous tow filter segment comprising an outer annular portion and a central portion defining a compartment. Neither Jupe nor Tateno teach such a structure and the Examiner does not address this claim recitation in the Office Action. As noted in MPEP §706.07, a final rejection is only appropriate when the applicant has had "a full and fair hearing, and that a clear issue between applicant and examiner" has been developed. In the present case, Applicants have not been adequately informed as to the Examiner's position regarding the teachings of the references, and thus, Applicants cannot fairly respond.

Claims 27, 4, 8, 13, 14, 20-26 and 33-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jupe *et al.* (WO 02/069745 A1) in view of Tateno *et al.* (U.S. 4,889,144). Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jupe *et al.* (WO 02/069745 A1) and Tateno *et al.* (U.S. 4,889,144), further in view of Jones *et al.* (US 5,307,823). Claim 45 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jupe *et al.* (WO 02/069745 A1) and Tateno *et al.* (U.S. 4,889,144), further in view of Berger (US 4,046,063).

In each rejection, the Examiner relies upon the Jupe reference as teaching a plug-space-plug filter arrangement with a central space filled with adsorbent and a downstream flavor bearing ribbon or thread. The Examiner relies upon Tateno as suggesting a filter segment containing breakable capsules. The Examiner alleges that the Tateno reference suggests an outer annular filter segment, but the Office Action is silent as to whether either reference suggests a longitudinally extending central portion of fibrous tow filter material defining a compartment. Applicants respectfully traverse these rejections.

To establish a *prima facie* case of obviousness, according to a test predominately used by the courts, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim elements. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

With regard to the Supreme Court's decision in *KSR Int'l. Co. v. Teleflex, Inc.*, 550 U.S. 398, 82 USPQ2d 1385 (2007), it is noted that the Court did not dismiss the usefulness of the well-established "teaching, suggestion, or motivation" test set forth above, but merely cautioned against its rigid application. The Supreme Court in *KSR* commented that the Federal Circuit "no doubt has applied the test in accord with these principles [set forth in *KSR*] in many cases." *Id.* 82 USPQ2d at 1396. However, the Supreme Court also opined that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. . ." *Id.* 82 USPQ2d at 1395-96. Regardless of the precise test used, the Court, quoting *In re Kahn*, cautioned that "'[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.'" *Id.* 82 USPQ2d at 1396.

First, as explained above, the main cited references, Jupe and Tateno, do not teach or suggest the claimed two-part filter segment structure recited in every claim of record.

Specifically, there is nothing in either reference to suggest a longitudinally extending section of fibrous tow filter material comprising: (1) a longitudinally extending central portion of fibrous tow filter material; (2) a longitudinally extending outer portion of fibrous tow filter material positioned annularly around the central portion; and (3) a compartment having a structure defined by the inner central portion. In fact, the Examiner does not even allege that Jupe or Tateno disclose such a structure. Rather, the Examiner notes that the Tateno patent teaches a capsule-filled compartment positioned coaxially within a filter segment, with no mention of two separate pieces of filter material present around the compartment. In fact, the figures of Tateno clearly fail to show such a filter arrangement. For at least this reason, Applicants respectfully request reconsideration and withdrawal of the rejection of claim 27.

In order to expedite prosecution, Applicants have amended the claims to recite further distinctions between the claimed invention and the cited art. In particular, the Tateno reference does not suggest the capsule composition set forth in the pending claims; namely, a gelatin outer shell or a triglyceride diluting agent. Instead, the Tateno patent suggests certain polysaccharides as the shell-forming material and certain powder components as the diluent. See column 2, lines 30-59. There is no suggestion to use gelatin or triglyceride materials. The Examiner appears to indicate that the sodium alginate in Example 1 is "gelatin." Applicants respectfully note that alginate materials are clearly not within the scope of gelatin, which is understood to be a collagen-derived material. For this additional reason, Applicants respectfully request reconsideration and withdrawal of the rejection.

Still further, Applicants note that the teachings of the Jupe reference with respect to claims 41-44 are clearly misrepresented in the Office Action. The Office alleges that the Jupe reference teaches that the mouth end filter segment has a low particulate efficiency and concludes that it would be obvious to use a lower particulate efficiency filter segment on the mouth end as compared to the tobacco end segment. This is a clear misrepresentation of Jupe. In sharp contrast to the allegations in the Office Action, the Jupe reference specifically teaches away from using a tobacco end filter segment with a higher particulate removal efficiency. On page 7, third paragraph, Jupe expressly notes that the tobacco end component should have the lowest particulate RTD of all of the filter components. This is confirmed by the exemplary

denier per filament (dpf) data provided in Table I on page 12, which lists a tobacco end filter component with a dpf of 5.0 and a mouth end filter component with a dpf of 3.0. Note that particulate removal efficiency is inversely proportional with denier per filament values, meaning that a lower dpf number equates to greater particulate removal efficiency. As a result, the Jupe reference clearly teaches away from the subject matter of claims 41-44, which recite the use of a higher particulate removal efficiency in the tobacco side filter segment (i.e., lower dpf value) as compared to the mouth side filter segment. For this additional reason, the rejection of claims 41-44 should be overcome.

Applicants note that the Examiner did not return an initialed PTO-1449 for the IDS submitted on 5/26/2009, which listed citations 149 and 150. For the convenience of the Examiner, a second copy of the IDS submission is enclosed. Applicants respectfully request that the Examiner formally consider the cited art and forward the initialed PTO-1449 form to the undersigned.

It is not believed that extensions of time or fees for net addition of claims are required, beyond those that may otherwise be provided for in documents accompanying this paper. However, in the event that additional extensions of time are necessary to allow consideration of this paper, such extensions are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,

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APPENDIX

Submitted with Amendment filed December 17, 2009, for:

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